

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VOLKER NITSCHKE and DR. WERNER SCHAIRER

Appeal No. 2000-2118
Application No. 08/995,139¹

HEARD: NOVEMBER 21, 2002

Before LALL, GROSS, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-5, which are all of the claims pending in the present application.

We reverse.

BACKGROUND

Appellants' invention is directed to an optoelectronic component suitable for mounting on a circuit board. External connecting leads all emerge from one lateral face of the

¹ Application for patent filed December 19, 1997, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of German Application 19653054.7, filed December 19, 1996.

component housing and are bent towards the rear face of the housing. The component may be placed on the board in two different positions providing for an optical path either perpendicular or parallel to the board surface. Additionally, in either position, the component is placed and aligned on the circuit board by both the supporting surfaces provided on the lateral face and the rear side of the housing as well as the bent external connecting leads.

Representative independent claim 1 is reproduced below:

1. An optoelectronic component for data transmission (1) with a radiation-emitting semiconductor chip (4.1) arranged on a first part of a conductor strip (3.1) and a semiconductor chip (5.1) that responds to radiation arranged on a second part of the conductor strip (3.1) and with a housing (2) that in certain sections at least is transparent for the radiation used for data transmission and which encloses the conductor strip (3.1) with the exception of the external connecting legs (3) of the conductor frame, all of which protrude from a single lateral face of the housing wherein all external connecting legs (3) are bent for the first time immediately behind the housing (2) such that they extend along the lateral face; and wherein all external connecting legs (3) are bent a second time at the edge to the rear side of the housing (2) such that they extend along the rear side; and wherein supporting surfaces (6,7) on which the housing rests are arranged on the lateral face at which the connecting legs emerge from the housing and on the rear side of the housing as required for the respective direction of mounting.

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The Examiner relies on the following references in rejecting the claims:

Rosenberg	5,506,445	Apr. 9, 1996
Lee	5,821,615	Oct. 13, 1998
		(filed Dec. 5, 1996)

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Lee.

We note that claims 1-5 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Isaksson in view of Lee in the final rejection (Paper No. 8, mailed July 21, 1999), which was neither included nor argued in the answer. This other ground of rejection is presumed to have been withdrawn by the Examiner since it was not included in the Examiner's answer. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

Rather than reiterate the viewpoints of the Examiner and Appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed July 17, 2000) for the Examiner's reasoning, and to the appeal brief (Paper No. 14, filed June 21, 2000) and the reply brief (Paper No. 18, filed August 16, 2000) for Appellants' arguments thereagainst.

OPINION

The Examiner relies on the teachings of Rosenberg for mounting an optical transceiver device in two different orientations (answer, page 3). The Examiner further relies on Lee for showing a semiconductor chip package with U-shaped leads extending over the edge of the package, which allows mounting in two different orientations (id.). Finally, the Examiner concludes that modifying Rosenberg's device with the package of Lee for providing "a uniform mounting technique that could be used for either orientation" would have been obvious (id.).

Appellants argue that the claimed position of the supporting surfaces on which the housing rests as "arranged on the lateral face at which the connecting legs emerge from the housing and on the rear side of the housing" is neither taught nor suggested by the cited prior art (brief, page 7). Additionally, Appellants assert that Rosenberg's device includes mounting feet 128 only on the rear side of the housing, not on the lateral face from which leads 126 extend (id.). Appellants also point to Rosenberg's tabs 124, which are identified as lead frame tabs, and distinguish them from the claimed supporting surfaces (reply brief, page 2).

In response to Appellants' arguments, the Examiner asserts that Rosenberg, as shown in Figures 4-6 (also shown on the cover page), teaches support surfaces on the back, the edge and the side of the package (answer, page 3). With respect to Lee, the Examiner points out that the reference is relied on only for showing wrapped-around leads (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Furthermore, the Examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in Graham v. John Deere Co., 383 U.S. 1 (1966). Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223

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USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

A review of Rosenberg confirms that the reference relates to an optical transceiver having a package assembly that is adaptable to different mounting positions by different ways of bending the external leads (col. 1, lines 57-65). Rosenberg further teaches that the package (as depicted in figures 3a-3d) includes leads 126 emerging from one side and lead frame tabs 124 extending from two other opposing sides as well as molded mounting feet 128 provided on the back side of the package. As leads 126 are bent differently for various mounting positions, mounting feet 128 and/or different configurations of lead frame tabs 124 provide structural support for the package (col. 3 lines 20-24). However, even if lead frame tabs 124 can be considered as support surfaces, they are on the sides different from the side where leads 126 emerge.

Lee, on the other hand, relates to the use of clip-type leads in a semiconductor chip package which does not require modification of the lead frame structure for different mounting positions. We also note that although Lee provides a chip package that may be mounted in both vertical and horizontal positions (col. 3, lines 63-65), nothing in the reference points

to supporting surfaces for providing structural stability to the mounted package.

We agree with Appellants' assertion (brief, page 7) that the combination of Rosenberg and Lee fails to teach or suggest supporting surfaces on the housing package arranged on the rear face and the lateral face from which the connecting legs emerge. As discussed above, none of the references recognize the importance of providing for different mounting positions of the package without requiring a differently designed component. Thus, assuming, arguendo, that it would have been obvious to combine Rosenberg with Lee, as held by the Examiner, the combination would still fall short of teaching the supporting surfaces on the lateral face of the housing.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness with respect to claim 1 because the necessary teaching and suggestion related to supporting surfaces on the lateral face of the housing, as recited in claim 1, neither are shown nor can be derived from the combination of the references. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claim 1, nor of claims 2-5 dependent thereon.

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CONCLUSION

In view of the foregoing, the decision of the Examiner
rejecting claims 1-5 under 35 U.S.C. § 103 is reversed.

REVERSED

PARSHOTAM S. LALL)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
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MAHSHID D. SAADAT)	
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